



Docket No.: 1793.1553

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Joo-Ho KIM et al.

Serial No. 10/514,422

Group Art Unit: 1794

Confirmation No. 8814

Filed: June 29, 2005

Examiner: Elizabeth E. MULVANEY

For: RECORDING MEDIUM HAVING HIGH MELTING POINT RECORDING LAYER, INFORMATION RECORDING METHOD THEREOF, AND INFORMATION REPRODUCING APPARATUS AND METHOD THEREFOR

COMMENTS REGARDING STATEMENT OF REASONS FOR ALLOWANCE

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

A Statement of Reasons for Allowance was forwarded in the Notice of Allowability mailed March 27, 2009.

MPEP §1302.14 states, in part:

Where specific reasons are recorded by the examiner, care must be taken to ensure that statements of reasons for allowance (or indication of allowable subject matter) are accurate, precise and do not place unwarranted interpretations, whether broad or narrow upon the claims. The examiner should keep in mind the possible misinterpretations of his or her statement that may be made and its possible estoppel effects.

The Examiner characterizes certain features of various claims. The reasons for allowance set forth starting on page 2 of the Notice of Allowability sets forth specific features not found in the prior art. It is submitted that the Examiner's statement is not an accurate quote with respect to independent claims 7, 13, 19, 25 and 31. For example, the apparatus of claim 13 does not recite "where recording is performed by irradiating the medium from the first dielectric

layer side and crystalline particles of the recording layer, the first dielectric layer, and the second dielectric layer are formed by diffusion/reaction." As such, it is submitted that the Examiner's statement is not a suitable reason for allowance. The claim language should be used to determine the reasons for allowance.

The foregoing is merely meant to be exemplary, and does not point out all of the discrepancies between the Examiner's Statement of Reasons for Allowance and the claimed features of the currently pending claims.

It is further submitted that the claims speak for themselves and should not be interpreted based on the Examiner's characterizations of same. It is also submitted that the claims provide their own best evidence as to the reasons for allowance.

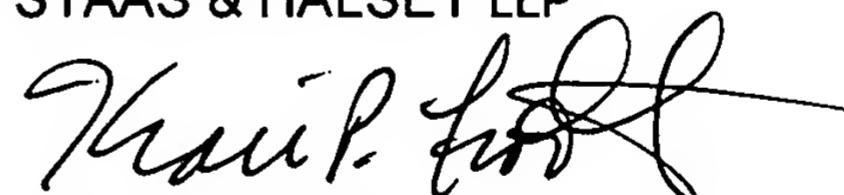
Further, the reasons for allowance set forth starting on page 2 of the Notice of Allowability include descriptions and characteristics of the references of record. It is submitted that such characterizations are not proper "reasons for allowance" as directed by 37 C.F.R. §1.104 and as explained in M.P.E.P. §1302.14. In particular, a discussion of the prior art is specifically identified in Example (F) of M.P.E.P. §1302.14 as a statement which is not a suitable reason for allowance.

In summary, it is submitted that the Examiner's Statement "raises possible misinterpretations... and possible estoppel effects" (M.P.E.P. §1302.14) and is therefore improper.

Respectfully submitted,

STAAS & HALSEY LLP

By:


Kari P. Footland
Registration No. 55,187

Date: 6/26/09

1201 New York Ave, N.W., Suite 700
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501